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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,311	12/16/2003	Dennis Kelly	1-24296	5955
46582	7590	06/27/2005	EXAMINER	
MACMILLAN, SOBANSKI & TODD, LLC ONE MARITIME PLAZA - FOURTH FLOOR 720 WATER STREET TOLEDO, OH 43604			BURCH, MELODY M	
			ART UNIT	PAPER NUMBER
			3683	

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/737,311	Applicant(s) KELLY ET AL.	
	Examiner Melody M. Burch	Art Unit 3683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/21/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/9/05</u>  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re: claims 1, 8, and 15. The limitation first recited in lines 6-7 of claim 1 of "said centrally located first aperture thereof" is indefinite. The use of the term thereof suggest that Applicant intends to refer to the adapter, however, the first aperture was previously recited as being formed in the backing plate. Clarification is required.

The remaining claims are indefinite due to their dependency from one claims 1, 8, and 15.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3, 4, 8, 10, 11, and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5865275 to Anger et al. in view of

Re: claims 1, 8, and 15. Anger et al. show in figure 3 a vehicle brake assembly

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comprising a backing plate 12 having a centrally located first aperture formed therein shown in the area surrounding element number 24, the backing plate 24 shown within element 12 (labeled element 20 in figure 2) adapted to support a drum brake shoe assembly 11 of a drum in hat parking and emergency brake, and a drum in hat adapter 16 having a centrally located second aperture as shown and a plurality of smaller mounting apertures shown to the left of the lead line of number 16 and to the right of the lead line of number 30 and disclosed in col. 3 line 6 formed therein about the centrally located first aperture thereof, the adapter being formed as a one piece stamping as disclosed in col. 3 line 5 and including an integral abutment member or portion shown in the area of the lead line of number 16 and in the area of element 30 (see marked up illustration in the Response to Arguments section) formed therewith during the stamping thereof.

Re: claims 3, 10, and 17. Anger et al. show in figure 3 the limitation wherein the adapter functions as an axle flange and is adapted to be secured to a vehicle axle tube as disclosed in col. 2 line 53.

Re: claims 4 and 11. Anger et al. show in figure 3 the assembly further including an axle flange or the inner portions of the unnumbered rotor in front of element 12; the axle flange adapted to be secured to an axle tube disclosed in col. 2 lines 53-56 which in turn is adapted to extend through the centrally located first and second apertures of the backing plate and the adapter, respectively.

Re: claims . Anger et al. show in figure 3 the limitation wherein the adapter includes a pair of ears (one of which shown in the area of the lead line of number 16 –

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see the marked up illustration in the Response to Arguments section), each of the ears provided with a hole formed therein as shown and adapted to receive a fastener for attaching a disc brake caliper assembly 14 to the adapter.

Re: claim 16. Anger et al. show in figure 3 the limitation wherein the adapter includes at least one raised solid projection shown in the area of the lead line of number 16 formed thereon or in an alternate interpretation wherein the adapter includes at least one raised solid projection 30 formed thereon.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 5, 6, 9, 12, 13, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5865275 to Anger et al.

Re: claims 2 and 9. Anger et al. show the limitation wherein the backing plate includes at least one raised hollow projection shown surrounding element 22 and the adapter includes at least one raised solid projection 30 which is adapted to be received into the at least one raised hollow projection.

Anger et al. fail to disclose how elements 16 and 24 are secured.

Anger et al. teach in the prior art section the use of a backing plate being fastened to an adapter via bolting as taught in col. 1 lines 51-52. Such an attachment can be considered as a form of metal forming operation, as broadly claimed, since the

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use of bolts for connecting causes the metal of one of the elements to be connected extending around the bolt to expand a small amount.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the means to fasten the backing plate to the adapter to have included bolting, as taught by the prior art section of Anger et al., in order to provide an old and well-known means of connecting the backing plate to adapter for proper functioning of the brake assembly.

Re: claims 5, 12, and 18. Anger et al. describe the invention substantially as set forth above, but do not include the limitation of the adapter being formed from carbon steel or high strength low alloy material.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the adapter being formed from carbon steel or high strength low alloy material since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Re: claims 6, 13, and 19. Anger et al. show in figure 3 the adapter having a generally uniform thickness.

Anger does not include the limitation of the thickness specifically being approximately 12.5 mm.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the thickness of the adapter of Anger to have been 12.5 mm or any other appropriate thickness, as best determined by routine

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experimentation, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

7. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5865275 to Anger et al. in view of US Patent 588732 to Anger et al.

Anger et al.'275 describe the invention substantially as set forth above, but do not include the claimed hole/aperture arrangement. Anger et al. '275 include the holes in the respective ears shown in the area of the lead line of number 16 in an alternate interpretation, but lack the presence of a plurality of smaller mounting apertures formed therein about the centrally located first aperture of the adapter.

Anger et al. '732 teaches in figure 3 the use of an adapter 31 with a plurality of mounting holes formed therein about the centrally located first aperture (in addition to the holes of the ears).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the adapter of Anger et al. '275 to have included a plurality of mounting apertures, as taught by Anger et al. '732, in order to provide a means of more securely attaching the adapter to the remaining brake components and to reduce the weight of the adapter.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 4, 11, and 15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 10, and 19 of U.S. Patent No. US Patent 6729444 to Schmandt et al. in view of Anger et al. '275. Both the instant application and the patent claim a vehicle brake assembly comprising a backing plate having a centrally located first aperture, a drum in hat adapter having a centrally located second aperture and a plurality of smaller mounting apertures, and an axle flange (claims 4 and 11). The limitations of the caliper bracket and the plurality of fasteners (and the axle flange with regards to claim 15) are covered by *In re Goodman*. In *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993), the court held that for the purposes of obvious double patenting a later genus (broad) claim is not patentable over an earlier species (narrow) claim.

Schmandt et al. lack the limitation of the adapter being formed as a one piece stamping and including an integral abutment member formed therewith during the stamping thereof.

Anger et al. '275 teach in col. 3 line 5 an adapter including an integral abutment member or portion shown in the area of the lead line of number 16 and in the area of



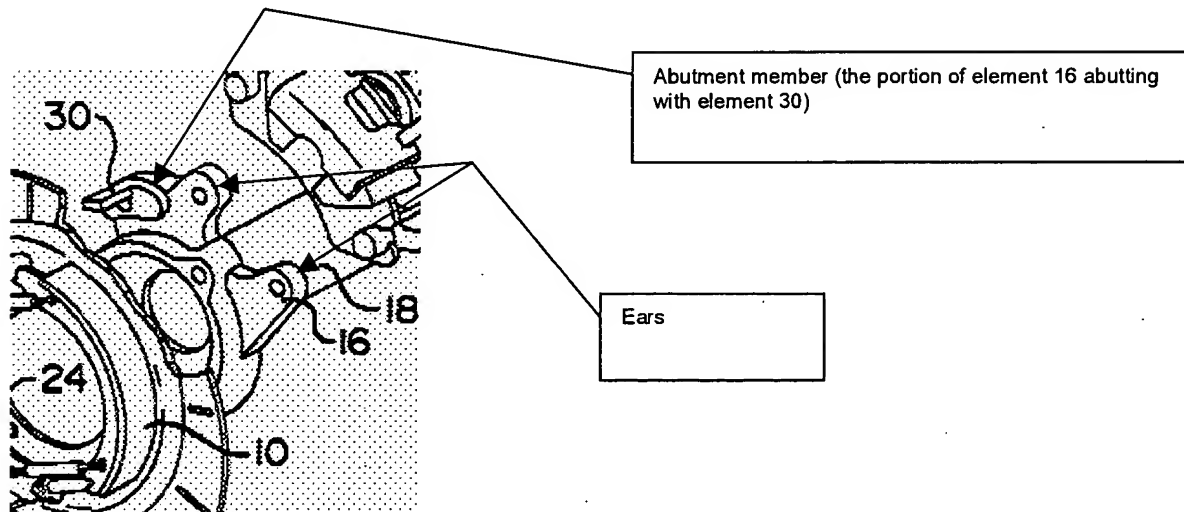
element 30 (see marked up illustration in the Response to Arguments section) formed therewith during the stamping thereof.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the adapter of Schmandt et al. to have include and adapter formed as a one piece stamping, as taught by Anger et al., in order to provide a means of simplifying production and to include an abutment member, as taught by Anger et al., in order to provide a means of receiving forces from the brake shoe ends.

### ***Response to Arguments***

10. Applicant's arguments filed 3/21/05 have been fully considered but they are not persuasive. Applicant argues that Anger et al. have an abutment member 30 which is casted onto element 16. Examiner notes that the argument is irrelevant since the Examiner set forth in the rejection that Anger et al. show in figure 3 a drum in hat adapter 16 being formed as a one piece stamping as clearly disclosed by Anger et al. in col. 3 line 5 and the adapter including an integral abutment member in the area of the lead line of 16 particularly the portion on the left side of element 16 abutting with element 30. Such member or portion of adapter 16 may be considered as an abutment member, as broadly claimed, since it abuts with element 30. Examiner also emphasizes that the ears (claimed in claim 7) include portions of the adapter 16 different from the abutment member. Each ear is shown in the area of the apertures

shown next to the lead line of number 16. Examiner has included a marked up version of the adapter of figure 3 to clearly set forth the various components of the adapter:



Applicant argues that the abutment member of Applicant's invention "as claimed in Claim 1 is there to receive 'an associated end of a brake shoe'...". Examiner notes that Claim 1 fails to recite that the abutment member receives an associated end of a brake shoe. Although Applicant's argument is more specific than the claim language, Examiner notes that since element 30 of Anger abuts with brake shoes 10 and transfers any force exerted on the brake shoes to the adapter 16, the abutment member of adapter 16 receives forces from an associated end of a brake shoe via element 30. Accordingly, Anger et al. clearly show and disclose an adapter including an integral abutment member formed therewith during the stamping thereof. Examiner also emphasizes that patentability of product claims limited and defined by a process is based on the product and not its method of production. See MPEP 2113.

### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 703-306-4618. The examiner can normally be reached on Monday-Friday (7:30 AM-4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on 703-308-0830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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mmb

~~December 9, 2004~~ June 23, 2005

Melody M. Burch  
6/23/05